

## **REMARKS**

Applicants respectfully request reconsideration of this application as amended.

### **Office Action Rejections Summary**

Claims 1, 2, 5 – 9, 11 – 13, 15 – 19, 21 – 24, 26, 28 – 30, 32, 34, 36, and 40 – 47 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,752,518 to McGee et al. (hereinafter “McGee”). Claims 3, 4, 10, 14, 20, 25, 27, 31, 33, 35, and 39 have been rejected under 35 U.S.C. §103(a) as being unpatentable over McGee and further in view of U.S. Patent 4,587,972 to Morantte, Jr. (hereinafter “Morantte”).

### **Status of Claims**

Claims 1 – 5, 7 – 21, 32 – 35, and 44 – 46 remain pending in the application. Claims 1, 15, 32, 34, and 44 have been amended. The amended claims are supported by the specification and no new matter has been added. Claims 26 – 27 have been canceled without prejudice. No new claims have been added. In light of the canceled claims, the following remarks pertain to the claims still pending.

### **Claim Rejections Under 35 U.S.C. §102(b)**

Claims 1, 2, 5, 7 – 9, 11 – 13, 15 – 19, 21, 32, 34, and 40 – 46 have been rejected under 35 U.S.C. 102(b) as being anticipated by McGee. Applicant respectfully submits that claims 1, 2, 5, 7 – 9, 11 – 13, 15 – 19, 21, 32, 34, and 40 – 46 are patentable over McGee.

McGee discloses a fiber optic assembly for visualization of tissue. The IAE 50 comprises the distal end 220 of an optic fiber path 222. The distal end 220 is embedded within an inner sheath 224, which is carried within an outer sheath 226. The outer sheath

226 extends in the distal body region 40, within the support structure 20. The inner sheath 224 includes a lens 228, to which the distal fiber path end 220 is optically coupled. The inner sheath 224 terminates in an angled mirror surface 230, which extends beyond the end of the outer sheath 226. The surface 230 reflects optical energy along a path that is generally perpendicular to the axis of the distal end 220. (McGee, col. 8, lines 18 – 28, and FIG. 25). Nothing in McGee discloses a separate enclosure that covers inner sheath 224 (which forms optical fiber path 222). Moreover, nothing in McGee discloses a coil-like enclosure for the fiber path.

In contrast, independent claims 1, 15, 32, and 34 each include the limitation of an optical fiber disposed within “a coil-like enclosure.” As such, applicant respectfully submits that claims 1, 32, and 34 are not anticipated by McGee under 35 U.S.C. §102(b) and request removal of the rejection. Claims 2, 5, 7 – 9, and 11 – 13 depend either directly or indirectly from independent claim 1. Claim 33 depends from independent claim 32. Claim 35 depends from independent claim 34. As such, all these dependent claims include the limitation of “a coil-like enclosure.” Accordingly, claims 2 – 5, 7 – 9, 11 – 13, 33, and 35 are also patentable over McGee under 35 U.S.C. §102(b).

#### Claim Rejections Under 35 U.S.C. §103(a)

Claims 3, 4, 10, 14, 20, 33, 35 and 39 have been rejected under 35 U.S.C. §103(a) as being unpatentable over McGee and further in view of Morantte. Applicant respectfully submits that claims 3, 4, 10, 14, 20, 33, 35 and 39 are patentable over McGee and Morantte. Claims 3, 4, 10, and 14 depend from independent claim 1, claim 20 depends from independent claim 15, claim 33 depends from independent claim 32, and claim 35 depends from independent claim 34. As such, claims 3, 4, 10, 14, 20, 33, and 35 each include the

limitation of “a coil-like enclosure.” As discussed above, nothing in McGee discloses or suggests these limitations.

Morantte discloses an intravascular device in which the chamber 30 of the housing 12 contains a fiberoptic bundle 60 comprising a plurality of elongated, fiberoptic fibers 62 disposed in substantially axially parallel relation and extending longitudinally within the chamber from the proximal end portion 15 to the distal end portion 18. The fibers 62 can be constructed of any suitable conductive material adapted to conduct light from a light source axially through the fiber and, preferably, the fibers are constructed of such material which is particularly adapted to conduct light from a laser-generating source axially therethrough and to emit such light from the tip 19. (Morantte, col. 4, lines 43 – 55, and FIGS. 2 – 4).

Morantte also discloses a sheath that covers not the fiberoptic bundle 60, but rather an electrode bundle 85 having a plurality of electrical conductors or electrodes 87 extending longitudinally within the chamber 30. (Morantte, col. 6, lines 38 – 44, and FIGS. 2 – 4).

Moreover, nothing in Morantte discloses or suggests a coil-like enclosure for the fiberoptic bundle that is bonded to a sheath or inner member. As such, Morantte fails to cure the deficiency of McGee.

The combination of Morantte and McGee does not teach the limitations of independent claims 1, 15, 32, and 34. As such, the combination cannot be interpreted to disclose the limitations of claims 3, 4, 10, 14, 20, 33, 35, and 39. Therefore, applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination.

If the allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Suk Lee at (408) 720-8300. If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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